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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,453	11/05/2001	Bernd Fabry	H 4132 PCT/US	1938
23657	7590	11/18/2004	EXAMINER	
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			JIANG, SHAOJIA A	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/009,453	<b>Applicant(s)</b> FABRY ET AL.	
	<b>Examiner</b> Shaojia A. Jiang	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9,10,12-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9,10,12-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

In view of the appeal brief filed on August 20, 2004, PROSECUTION IS HEREBY REOPENED. In view of new prior art, a new ground(s) of rejection(s) set forth below. All rejections on appeal are withdrawn and therefore moot.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

This application is a 371 (a national stage entry) of PCT/EP00/03763 of International Filing Date: 04/26/2000, which claims foreign priority to German 199 20 555.8 filed May 5, 1999, under 35 U.S.C. 119(a)-(d). The copy of certified copy of the priority has been filed with the instant Application. It is noted that PCT/EP00/03763 and the Germany Application are in Germany, no translation into English is provided.

Currently, claims 9-10, 12-16, and 18-24 are pending in this application. Claims 1-8, 11, and 17 are cancelled previously.

Claims 9-10, 12-16, and 18-24 are examined on the merits herein.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-10, 15-16, and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Selvaraj et al. (WO 97/13503, PTO-892).

Selvaraj et al. discloses a composition comprising

(a) an active ingredient such as a cosmetically-active agent, or a pharmaceutically-active or therapeutic agent; and

b) nanoparticles having a mean diameter within the instant range such as less than 250 nm (see page 5 line 28) or about 90 nm (see page 7 line 21) or about 100 nm (see page 9 line 19-20 and page 12 line 20-21), comprising metal soap such as calcium stearate (see page 6 line 19), a protective colloid such as a protein which is gelatin(see page 6 line 3 and page 7 line 4); carbohydrate such as starch and gum arabic (see page 6 line 14-15), and an emulsifier and mixtures thereof (see page 6-7), and the process for making the composition therein, in particular the method or process for making the nanoparticles therein. See also abstract, page 4 line 21 to page 5; page 17; claims 1-27 therein.

Selvaraj et al. also discloses that nanoparticles are present in the composition in an amount about 10% or 15% wt or at least 10% wt (see page 11 line 27 to page 12 line 1). Selvaraj et al. further teaches that process parameters such as size of nanoparticles and the weight percentage of nanoparticles in the composition, can be determined by one of ordinary skill using the teaching of Selvaraj et al. in WO 97/13503 (see page 10 line 1-7).

Thus, the disclosure of Selvaraj et al. anticipates claims 9-10, 15-16, and 21-24.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selvaraj et al. (WO 97/13503, PTO-892).

The same disclosure of Selvaraj et al. has been discussed in the 102(b) rejection above.

The cited prior art does not expressly disclose that the amount of the nanoparticles in the composition therein is from 0.1 to 5.0% or 0.5 to 3 % or 1 to 2% by weight.

Art Unit: 1617

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine the amount of the nanoparticles in the composition therein to be from 0.1 to 5.0% or 0.5 to 3 % or 1 to 2% by weight.

One having ordinary skill in the art at the time the invention was made would have been motivated to determine the amount of the nanoparticles in the composition therein to be from 0.1 to 5.0% or 0.5 to 3 % or 1 to 2% by weight, since the amount of the nanoparticles in the composition of Selvaraj et al. is known to be about 10% or 15% wt. Selvaraj et al. further teaches that process parameters such as the weight percentage of nanoparticles in the composition and size of nanoparticles, can be determined by one of ordinary skill using the teaching of Selvaraj et al. in WO 97/13503.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Thus the claimed invention as a whole is seen to be prima facie obvious over the teachings of the prior art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 1617

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,716,438.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent, i.e. claim 9, is drawn to a method of making a composition comprising the same ingredients with the same method or process steps as claimed herein, such as nanoparticles with size, 5-500 nm, including alkali metal soaps of fatty acids (see the disclosure at col.6 line 44-56).

Thus, the instant claims 15-16 are seen to anticipate claim 9 of U.S. Patent No. 6,716,438.


In view of the rejections to the pending claims set forth above, no claims are allowed.

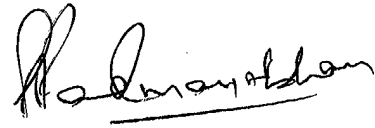
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
S. Anna Jiang, Ph.D.  
Primary Examiner, AU 1617  
November 13, 2004

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER